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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,797	10/11/2001	Michael L. Walker	194-15337CIP	9540

24923 7590 03/19/2004
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HOUSTON, TX 77057-1130

EXAMINER


TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/975,797	WALKER, MICHAEL L.	
	Examiner	Art Unit	
	Philip C Tucker	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,10-13,15-17 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-5,10,11,13,15-17 and 22-24 is/are allowed.
- 6) ☒ Claim(s) 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. The finality of the last office action is withdrawn, and superceded by the office action in the present paper. In an interview on 3/1/04 it was agreed that an amendment to cancel lithium, potassium and cesium from the claims would distinguish over Atkinson. Further examination of the prosecution history, indicates that claim 12 would however still be rejected over the JP 63-199278 A reference.

Claim Objections

2. Claim 12 is objected to because of the following informalities: Claim 12 contains ammonia as part of the Markush grouping twice, at lines 7 and 13. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim12 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 63-199278 A.

JP '278 teaches a heavy brine of calcium chloride which comprises ethylene diamine and/or diethylene triamine as corrosion inhibitors. They are both encompassed

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by the scope of applicants compound of formula $R^1R^2R^3N$ in claim 12. JP'278 exemplifies the use of such corrosion inhibitors in brines of 29.9% calcium chloride, which are approximately 10.8 lbs/gal brines. JP '278 differs from the present invention in that brines as high as 11 lbs/gal density are not disclosed. It would be obvious to one of ordinary skill in the art to utilize the corrosion inhibitors of JP '278 in brines of 11 lbs/gal density, since such brines would be expected to have similar corrosive properties with brines of extremely close density, such as of 10.8 lbs/gal.

5. Claims 1, 3-5, 10, 11, 13, 15-17 and 22-24 are allowable over the art of record.

6. As noted in applicants arguments, the amendment to delete lithium, potassium and cesium from the claims 1 and 12 distinguishes over Atkinson.

A review of the record shows that a rejection of JP '278 was initially made in the office action of 5/20/03. Applicants amended the claims in the response of 7/11/03, and limited claim 12 by indicating the additive was selected from the Markush group at the end of the amended claim (see also the paragraph at the bottom of page 14 of applicants response). Although this created issues under 35 USC 112, it was indicated in the office action of 9/23/03 that this distinguished over the JP '278 reference, since the intention was to limit the additive to the species of the Markush group at the end of the claim. Applicant amended claim 12 to incorporate the Markush grouping into the body of the claim in the amendment of 11/12/03, thus also including ethylene diamine and compounds of formula $R^1R^2R^3N$ as part of the possible additive species. This

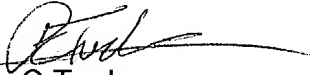
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again rendered JP '278 as prior art over claim 12, however such was not instantly recognized. This is corrected in the present office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-2970